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EXAMINER	
SMITH, NICHOLAS A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALEXANDR NIKOLAEVICH ZAJCEV,
NASICH ZIJATDINOVICH GIMAEV, NATALYA MARKELOVA,
VIKTOR KUCENKO, ALEKSANDR LEONIDOVICH BELOGORSKY,
RAFAIL RAMZISOVICH MUCHUTDINOV, and
IGOR LEONIDOVICH AGAFONOV

Appeal No. 2009-008124
Application S.N. 10/511,811
Technology Center 1700

Before BEVERLY A. FRANKLIN, LINDA M. GAUDETTE, and KAREN M. HASTINGS, *Administrative Patent Judges.*

FRANKLIN, *Administrative Patent Judge.*

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-15. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

Claim 1 is representative of the subject matter on appeal and is set forth below:

> 1. A method for determining an optimal mode for a removal of cathode depositions from an electrode during an electrochemical machining of an electrically conductive work piece in an electrolyte by means of applying bipolar electrical pulses between the work piece and the electrode, one or more voltage pulses of an unipolar machining polarity being alternated with voltage pulses of an inverse polarity while a gap between the work piece and the electrode is maintained, said gap being filled by the electrolyte, wherein during said optimal mode an optimal duration of the pulses of the inverse polarity is selected, said optimal duration being determined from a first calibration carried out preceding the machining of the work piece and a second calibration carried out during the machining of the work piece.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Gimaev et al	5,833,835	Nov. 10, 1998
Zhou et al	6,402,931 B1	Jun. 11, 2002
Taylor	6,558,231 B1	May 6, 2003

THE REJECTIONS

1. Claims 1, 10, and 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Taylor and Zhou (as incorporated by reference therein (Taylor col. 2, line 62)).

2. Claims 2-9 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor, as applied to claim 1 above, and further in view of Gimaev.

ISSUE(S)

Did the Examiner err in determining that the applied art discloses the subject matter of claim 1, and, in particular, the subject matter of "wherein during said optimal mode an optimal duration of the pulses of the inverse polarity is selected, said optimal duration being determined from a first calibration carried out preceding the machining of the work piece and a second calibration carried out during the machining of the work piece"?

We answer this question in the affirmative and REVERSE.

ANALYSIS
(with Findings of Fact and Principles of Law)

We select claim 1 for consideration in this appeal based upon Appellants' arguments. Our determination with regard to rejection 1 is dispositive with regard to rejection 2 (rejection 2 is deficient for the same reason that rejection 1 is deficient). Hence, our focus is on the reference of Taylor (and Zhou which is incorporated by reference in Taylor).

We agree with Appellants that Taylor and Zhou do not teach determination of an optimal pulse duration based on a first calibration carried out prior to machining and a second calibration carried out during machining. We refer to Appellants' position as set forth in their Brief and Reply Brief in this regard.

We note that "unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the

limitations *arranged or combined in the same way as recited in the claim*, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102." *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (emphasis added). In the instant case, the Examiner's findings are lacking in that the Examiner does not point to disclosure in Taylor (and Zhou) of selecting optimal pulse duration based on a first calibration carried out prior to machining and a second calibration carried out during machining. Taylor and Zhou discuss independent steps involving adjusting settings in a machining process, but these steps are not as claimed. We therefore reverse the anticipation rejection.

The Examiner in the present case has not based any rejection for our review on a theory involving obviousness[2] regarding the above-identified issue, and thus we take no position on such an issue in the present opinion. *See, e.g., Ex Parte Frye*, No. 2009-006013, 2010 WL 889747, *3 at *6 (BPAI) (Precedential) ("Our decision is limited to the finding before us for review.").

CONCLUSIONS OF LAW AND DECISION

1. The rejection of claims 1, 10, and 13-15 under 35 U.S.C. 102(e) as being anticipated by Taylor and Zhou (as incorporated by reference therein (Taylor col. 2 line 62)) is reversed.

[2] Rejection 2 is an obviousness rejection but does not involve obviousness regarding the issue discussed, *supra*.

2. The rejection of claims 2-9 and 11-12 under 35 U.S.C. 103(a) as being unpatentable over Taylor as applied to claim 1 above and further in view of Gimaev is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

REVERSED

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